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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,982	03/25/2004	Carl A. Caspers	55508-296809	7038

25764 7590 12/04/2006

FAEGRE & BENSON LLP
PATENT DOCKETING
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55402-3901

EXAMINER	
WILLSE, DAVID H	
ART UNIT	**PAPER NUMBER**
3738	

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/808,982	CASPERS, CARL A.	
	Examiner	Art Unit	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7-9-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

In the Information Disclosure Statement of July 9, 2004, the Japanese patent document was not considered because a complete copy (37 C.F.R. § 1.98(a)(2)) was not presented (and the Information Disclosure Statement does not properly identify a prior application in which a complete copy was presented: MPEP § 609.04(a)).

The disclosure is objected to because of the following informalities: On page 4, line 28, "significance" should be replaced by --significant--. On page 5, line 14, "amputee" should be replaced by --amputees--. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6-8 are vague and indefinite as to which of the "means for reducing loss of vacuum" (claim 1, last four lines) is being referenced, particularly since the word "comprises" (claims 6-8, line 2 of each; emphasis added) implies a *singular* subject in each clause of the respective further limitation.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s) (e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,726,726 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present limitations are found in the claims of the patent. The means for reducing loss of vacuum involve seal means (patent claim 1(d)) in combination with a regulator (patent claims 1(e), 7, 11, and 12). Regarding instant claim 10, the even distribution of vacuum about the liner is set forth in patent claim 1(f), for example.

Claims 1-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,926,742 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current features appear in the patent claims. The means for reducing loss of vacuum include seal means (column 15, line 45) and a regulator (column 15, lines 65-67; column 16, lines 11-12).

Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,974,484 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed elements are stated in or would have been obvious from the patent claims. The means for reducing loss of vacuum comprise a nonporous seal (column 6, line 13) and a regulator (patent claims 12 and 14). A single socket would have been obvious to one of ordinary skill because only one socket is mentioned in the patent claims and a suction socket system typically

has only one socket. Regarding claim 10 and others, attention is directed to the porous thin sheath adjacent the liner (column 6, lines 8-9).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8, and 9 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Helmy, US 6,231,616 B1, which illustrates a means **22** and **30** for applying vacuum to a residual limb received within a socket (Figures 4-6; column 7, line 7 et seq.) and means **29** and **32** for reducing loss of vacuum against the residual limb during the gait cycle (Figures 4-6; column 6, lines 38-45; column 7, line 46 et seq.), including weight-bearing and swing phases. Regarding claim 4 and others, a vacuum reservoir is inherently created, for example, in the conduits **22** by the vacuum pump **30**.

Claims 7 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmy, US 6,231,616 B1. Regarding claim 7 and others, suspension sleeves were well known in the art at the time of the present invention and would have been obvious in order to provide a

sealing means between the outer liner **34** and the socket so as to maintain the vacuum generated between these two components (column 7, lines 39-45; column 8, lines 5-11). Likewise, with regard to claim 10 and others, a seal member (such as a suspension sleeve) to seal the space between the outer liner **34** and the socket would have been immediately obvious, if not inherent, for the same reason, and applying a designated vacuum pressure evenly over the liner **34** would have been inherent from the contemplated use of more than one tube or conduit **22** (column 7, lines 39-41) and/or from the need to minimize air gaps at various regions of the prosthetic socket inner surface **50** (column 7, lines 27-38 and 54-58). Regarding claim 14, weight actuated pumps were also well known in the art and would have been obvious in order to eliminate the need for an external power source.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Dave Willse
Primary Examiner
Art Unit 3738